

## **REMARKS**

The Examiner has:

- I. Objected to Claim 18 because GDBD is not spelled out the first time it is used;
- II. Objected to Claim 20 because the words “derived from” appear twice;
- III. Rejected Claims 19 and 20 under 35 U.S.C. Section 112, second paragraph;  
and
- IV. Rejected Claims 17, 19, 20, 24, and 25 under 35 U.S.C. 102(b).

We respectfully disagree. Nonetheless, without acquiescing to the Examiner’s rejections, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicant has amended Claims 17, 19, 20, and 24. Moreover, Applicant has corrected Claim 20 and cancelled Claim 18, rendering the objection moot.

### **I. Objectionable Claims Have Been Corrected or Cancelled**

The Examiner has objected to Claim 18 for failure to spell out the DNA-binding moiety GDBD the first time it is used in the application. Applicant has cancelled Claim 18, rendering the objection moot.

The Examiner has objected to Claim 20 for inserting the words “derived from” twice. Applicant has removed the words “derived from” from Claim 20, rendering the objection moot.

### **II. The Claims Specifically Describe the Claimed Invention**

The Examiner has rejected Claims 19 and 20 under 35 U.S.C. Section 112, second paragraph. We respectfully disagree. Nonetheless, without acquiescing to the Examiner’s rejections, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicant has amended Claim 19 to recite “...a library of plasmids containing DNA inserts ~~selected~~ from the group consisting of genomic DNA, cDNA, and synthetically generated DNA.” Furthermore, Claim 20 has been amended to recite “...said first test protein ~~is selected~~ from the group consisting of bacterial protein, viral protein, oncogene-encoded protein, fungal protein and plant protein.”

### **III. The Claims Are Not Anticipated**

The Examiner has rejected Claims 17, 19, 20, 24, and 25 under 35 U.S.C. 102(b) as allegedly being anticipated by Van Crieke et al, hereinafter “Van Crieke”. We respectfully disagree. Nonetheless, without acquiescing to the Examiner’s rejections, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicant has amended Claims 17, 19 and 20.

#### **Claim 17**

The Examiner has rejected Claim 17 as being anticipated by Van Crieke. We respectfully disagree. Since the reference does not identically describe each and every element of the claim, it is not a proper 102 reference. *Atlas Powder v. E.I. duPont*, 224 U.S.P.Q. 409 (Fed. Cir. 1984). There is no recitation of the chimera described by the Applicant in Van Crieke. Specifically, Van Crieke does not describe a hybrid protein possessing a reactive moiety amenable to post-translational modification and a catalytic domain capable of post-translationally modifying said reactive moiety. Thus, Van Crieke has not anticipated every element of Applicant’s claimed invention. Nonetheless, without acquiescing to the Examiner’s rejections, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicant has amended Claim 17 to recite “...an amino acid sequence comprising a transcriptional activation domain...”. Applicant has also amended Claim 17 to recite “...said DNA-binding moiety comprising the Gal4 DNA binding domain, hereinafter GDBD...”, further amended Claim 17 to recite “...said reactive moiety comprising a histone amino terminal tail capable of being acetylated by Gcn5...”, and still further amended Claim 17 to recite “...said catalytic moiety comprising the catalytic domain of Gcn5...”.

#### **Claim 19**

The Examiner has rejected Claim 19 as being anticipated by Van Crieke. We respectfully disagree. Claim 19 is dependent on Claim 17 and thus contains all of the limitations of Claim 17. Since Van Crieke does not anticipate Claim 17, as described above, it does not anticipate Claim 19.

#### **Claim 20**

The Examiner has rejected Claim 20 as being anticipated by Van Crieke. We

respectfully disagree. Claim 20 is dependent on Claim 17 and thus contains all of the limitations of Claim 17. Since Van Crieke does not anticipate Claim 17, as described above, it does not anticipate Claim 20.

#### **Claim 24**

The Examiner has rejected Claim 24 as being anticipated by Van Crieke. We respectfully disagree. Since the reference does not identically describe each and every element of the claim, it is not a proper 102 reference. *Atlas Powder v. E.I. duPont*, 224 U.S.P.Q. 409 (Fed. Cir. 1984). There is no recitation of the chimera described by the Applicant in Van Crieke. Specifically, Van Crieke does not describe a hybrid protein possessing a reactive moiety amenable to post-translational modification and a catalytic domain capable of post-translationally modifying said reactive moiety. Thus, Van Crieke has not anticipated every element of Applicant's claimed invention. Nonetheless, without acquiescing to the Examiner's rejections, but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicant has amended Claim 24 to recite "...an amino acid sequence comprising a transcriptional activation domain...". Applicant has also amended Claim 24 to recite "...said DNA-binding moiety comprising the Gal4 DNA binding domain, hereinafter GDBD...", further amended Claim 24 to recite "...said reactive moiety comprising a histone amino terminal tail capable of being acetylated by Gcn5...", and still further amended Claim 24 to recite "...said catalytic moiety comprising the catalytic domain of Gcn5...".

#### **Claim 25**

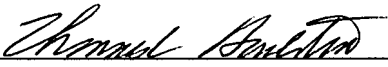
The Examiner has rejected Claim 25 as being anticipated by Van Crieke. We respectfully disagree. Claim 25 is dependent on Claim 24 and thus contains all of the limitations of Claim 24. Since Van Crieke does not anticipate Claim 24, as described above, it does not anticipate Claim 25.

**CONCLUSION**

Applicant respectfully request that the Examiner's rejections under 35 U.S.C. §§ 112 and 102(b) be withdrawn and that the pending Claims be allowed. Moreover, Applicant has corrected Claim 20 and cancelled Claim 18, rendering the objection moot. Should the Examiner believe a telephone interview would aid in the prosecution of this application, the Applicant encourage the Examiner to call the undersigned at 617.984.0616.

Respectfully submitted,

Dated: May 15, 2007

  
\_\_\_\_\_  
Thomas C. Howerton  
Registration No. 48,650

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
617.984.0616